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6 RECORD OF ORAL HEARING
7 UNITED STATES PATENT AND TRADEMARK OFFICE
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10 BEFORE THE BOARD OF PATENT APPEALS
11 AND INTERFERENCES
12
13

14 *Ex Parte* ANTON ESSER, RAINER BLUM, JOACHIM KUHN,
15 MARC LEDUC, and RALF HEMEL
16

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18 Appeal 2010-011924
19 Application 10/590,933
20 Technology Center 1700
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23 Oral Hearing Held: Wednesday, October 26, 2011
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26 Before CHARLES F. WARREN, BEVERLY A. FRANKLIN, and
27 MICHAEL P. COLAIANNI, *Administrative Patent Judges*.
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30

31 ON BEHALF OF THE APPELLANT:
32 HARRIS A. PITLICK, ESQ.
33 Oblon, Spivak, McClelland, Maier, & Neustadt
34 1940 Duke Street
35 Alexandria, Virginia 22314
36

1 *The above-entitled matter came on for hearing on*
2 *Wednesday, October 26, 2011, commencing at 1:22 p.m., at the U.S.*
3 *Patent and Trademark Office, 600 Dulany Street, 9th Floor, Hearing*
4 *Room D, Alexandria, Virginia.*

5
6 THE USHER: 924, Mr. Pitlick.

7 JUDGE WARREN: Good afternoon, Mr. Pitlick.

8 MR. PITLICK: Good afternoon, Your Honors.

9 JUDGE WARREN: Ms. Allen is our court reporter today.
10 (inaudible) Ms. Carter (inaudible) thank you very much. As you
11 know, sir, you have 20 minutes. You may begin when ready.

12 MR. PITLICK: Okay, what we have here is a process for
13 producing paper, cardboard, etc...We have two independent claims --
14 Claims One and Nine. Before I get into the argument, though, there
15 are five rejections -- two over prior art and three over obviousness
16 type double-patenting. When these briefs were written, the three
17 double-patenting rejections were over pending applications. Since
18 then, two of them have become patents. I'm not sure if the Board is
19 aware of that, but -- okay, apparently you're not. So let me at least
20 update you.

21 The rejection over serial number 11/574677 -- that
22 application is now a patent, US8029647. Application number
23 12/065688 is now patent 7918965. However, our arguments in the
24 briefs -- let's say the claims of these applications now patented -- that

1 has not changed. To the extent that you may have any questions, you
2 can certainly ask me questions with regards to things I've said in the
3 briefs, or otherwise. So, our position hasn't changed.

4 So, let me get to the heart of the matter, to the invention
5 here. We're dealing with papermaking; we're particularly dealing with
6 drainage of what's known as High-Consistency Paper Stock. And
7 we're using a particular polymer having vinylamine units. Now, the
8 important thing -- three things that are important in this invention.
9 Number one, we're adding this drainage aid to the high-consistency
10 stock as opposed to the low-consistency stock. After the polymer is
11 added, the high-consistency stock is diluted to become low-
12 consistency stock. So that's one important consideration for the future
13 of the invention.

14 The other two concern the vinylamine unit-containing
15 polymer per se. Number one, it has to have a degree of hydrolysis
16 from 1 to 20 mole-percent. It also has to have a molar mass molecular
17 weight of at least 1 million. We have comparative data in the
18 specification and in a 132 declaration demonstrating the significance
19 of these three features that I've mentioned. I might also add that one
20 of the comparative examples in the specification compares the present
21 invention to a -- let's say an analogous invention using -- I believe it
22 was an aluminum chloride, let me just be sure about that.
23 Polyaluminum chloride, which has also been used for this purpose.

1 So as I mentioned at the beginning, we have two prior art
2 rejections; one of them is in view of Burke, in view of Hund. Now,
3 Burke discloses the basic papermaking invention but doesn't disclose
4 the particular polymer -- although they disclose other particular
5 polymers, including the polyaluminum chorlide that I mentioned. So
6 the Examiner relies on Hun -- Hund. Hund basically is drawn to a
7 method of making various polyvinylamine polymers, and they disclose
8 many different utilities that are used in papermaking.

9 But the important thing is there's no distinction in that
10 disclosure with regard to the molecular weight of the -- sorry, the
11 minimum molecular weight of the polymer, or the degree of
12 hydrolysis. So, as we've pointed out in the briefs, there's no prima
13 facie case of obviousness, but -- at least our data is evidence of
14 patentability. Number two, we've also argued that, to the extent the
15 Examiner finds a prima facie case and has considered our comparative
16 data, he's taken the wrong approach. He's basically treated this data
17 for its, as has been quoted before in some of the earlier CCPA and
18 Federal Circuit cases, for its knockdown ability. But hasn't taken the
19 approach stated in cases like *In re Carleton*, which we cited in the
20 brief, that once there is such data, all the evidence has to be
21 considered anew. So even if there were a prima facie case, and of
22 course we say there wasn't, the Examiner still hasn't properly
23 considered the evidence.

1 The second rejection over prior art is over Auhorn and
2 Burkert, et al. We realize, and we pointed this out in the Reply Brief,
3 Burkert et al. was simply replied to because it's referred to in Auhorn,
4 et al. So basically, the Examiner's relying on Auhorn, et al. And here
5 again, Auhorn mentions various types of -- let's say cationic agents for
6 various papermaking utilities, but no particular realization of a
7 minimum molecular weight of 1 million or a degree of hydrolysis
8 within the 1 to 20% range. Our position on the data and the
9 Examiner's treatment of the data is the same with respect to this
10 rejection as well as the previous one. Namely, there's no prima facie
11 case, and number two, even if there was, Examiner has not considered
12 all the evidence appropriately, based on binding precedent.

13 As opposed to the three double-patenting rejections, again,
14 I think what we've argued in our briefs still apply, and I don't think
15 there's anything more that needs to be added. So to the extent that any
16 of the members of the Board have any questions, I'd be happy to try to
17 answer that.

18 JUDGE WARREN: Got any questions, Judge Franklin?

19 JUDGE FRANKLIN: No questions.

20 JUDGE WARREN: Judge Colaianni?

21 JUDGE COLAIANNI: I do have one question, Mr.

22 Pitlick. With regard to the first rejection: the Examiner's position, as I
23 understand it, is that the primary reference, Burke, is teaching the
24 molar mass of the particular coagulant. And he's adding this

1 vinylamine from the secondary reference in. Is it your position that
2 the secondary reference doesn't lead you to manipulate that molar
3 mass of the secondary reference -- that vinylamine of the secondary
4 reference -- to arrive at the coagulant that you'd use in Burke?

5 MR. PITLICK: All right, I don't believe we've even -- I
6 don't remember arguing a distinction between molar and -- let me just
7 take another quick look at the claims. All right, we have average
8 molar mass and -- I'm sorry, Judge Colaianni, would you please repeat
9 the question?

10 JUDGE COLAIANNI: Sure. My understanding of the
11 Examiner's position, with regard to the rejection over Burke, in view
12 of Hund, is that Burke teaches a coagulant having the particular
13 molecular weight or molar mass, that overlaps what you're claiming.
14 And he's relying on the secondary reference, Hund, to teach a
15 particular vinylamine coagulant that you could use. My understanding
16 from your argument is that your position seems to be that the
17 secondary reference doesn't disclose anything about molar mass, and
18 the primary reference -- that doesn't get you to be where you need to
19 be, at having the particular molar mass?

20 MR. PITLICK: Well, I'm not quite sure I understand the
21 question, but I'll try to answer as best I can. If I haven't answered it,
22 please ask it again.

23 JUDGE COLAIANNI: Sure.

1 MR. PITLICK: We're not saying that -- let's say if you
2 were using a different polymer, that you would -- you've got to
3 consider the molecular weight and the particular polymer together. If
4 the prior art teaches a particular molecular weight but a different
5 polymer, to us, that's meaningless. Because -- let's say it has
6 disclosed a molecular mass overlapping ours, but you're talking about
7 different polymers. One (inaudible) would not necessarily think that,
8 well, you've got the molecular weight, you just don't have the
9 particular material. My point is they go together. It may very well be,
10 we don't know, that if you picked an entirely different polymer, maybe
11 or maybe not you would get similar results with different molecular
12 weights, or molar masses. Am I answering your question, or --

13 JUDGE COLAIANNI: Yeah, I'm just trying to get a -- I'm
14 trying to understand the Examiner's position and what your argument
15 is against it. My understanding is the Examiner is relying on Burke to
16 teach the particular molar mass. And it's just substituting in a
17 conventional coagulant, this vinylamine. And he's relying on Burke's
18 teaching that the coagulant can be a polyamine. My understanding is
19 that that's kind of the hook as to why you would manipulate or adjust
20 the particular vinylamine molecular weight of Hund, and arrive at
21 something that Burke is looking to have. Something with a particular
22 molecular weight that overlaps what you have claimed.

23 MR. PITLICK: Well, like we said. First, I know Hund
24 does have a fairly large molecular weight range, and I'm looking at the

1 top of column four. It goes -- he talks about 2 million, he talks about
2 down to 10 thousand, for example. And as you see, he talks about that
3 with respect to different polymers. And number two, which we did
4 actually specifically point out in the briefs, that a particular polymer
5 we have, regardless of hydrolysis value, the polyvinylamines are not
6 even listed in any of these. Although, as I say, the polyaluminum
7 chloride is, and we had a comparative example with respect to that.

8 But in order to get from Burke to our invention, first of all
9 you have to pick a polymer that's not even in there. Then you have to
10 adjust the hydrolysis value, then you have to also add it to the high-
11 consistency stock. We think that's too high a hill to climb in order to
12 get to a prima facie case. But, like I said, even if you decided there
13 was, we think all the evidence with our data convincingly shows that
14 we distinguish over that arc.

15 JUDGE COLAIANNI: Thank you.

16 MR. PITLICK: You're welcome.

17 JUDGE WARREN: I think the hearing is concluded.

18 (Whereupon, at approximately 1:30 p.m., the proceedings
19 were concluded.)